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TO: Art Unit 2183 U.S. Patent and Trademark Office	Fax No.: 703 872 9306 City: Alexandria	Telephone No.: 571 272 4165 State: Virginia
TO: Examiner Richard Ellis Art Unit 2183, U.S. Patent and Trademark Office	Fax No.: 703 872 9306 City: Alexandria	Telephone No.: 571 272 4165 State: Virginia

CONCERNING APPLICATION:

Applicant(s): John S. Yates, Jr., et al.

Serial No.: 09/385,394

Art Unit: 2183

Filed: August 30, 1999

Examiner: Richard Ellis

Title: COMPUTER WITH TWO DIFFERENT EXECUTION MODES

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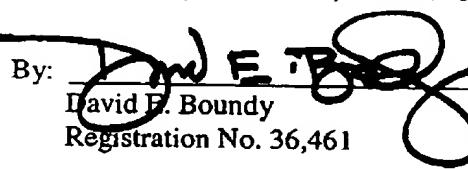
AFTER FINAL - EXPEDITED PROCEDURE

I hereby certify that the attached

- This FAX cover sheet
- Request to Withdraw Finality of Office Action
- Second Response to Office Action (including Petition for Extension of Time, and Exhibit A)
- Information Disclosure Statement and Form PTO-1449

along with any paper(s) referred to as being attached or enclosed) are being transmitted by facsimile on April 14, 2005 to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

ATTORNEY DOCKET NO. 114596-03-4000 **RECEIVED**
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APR 14 2005

Serial No.: 09/385,394

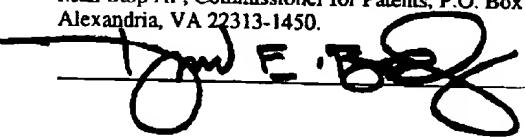
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Applicant: John S. Yates, Jr., et al.

Title: COMPUTER WITH TWO DIFFERENT EXECUTION MODES

Filed: August 30, 1999

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Art Unit: 2183

Examiner: Richard Ellis

Atty. Docket: 114596-03-4000

Customer No. 38492

AFTER FINAL - EXPEDITED PROCEDURE**REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION**

Mail Stop AF
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

Applicant requests that the final status of the Office Action of October 25, 2004, and on reconsideration February 14, 2005, be withdrawn. Pursuant to MPEP § 706.07(c) and (d), Petitioner requests that prosecution be reopened, and that the Response to Office Action filed herewith be entered as of right.

As in initial matter, Applicant notes that the Examiner has overlooked the key words in MPEP § 706.06(a), which reads, in pertinent part:

706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims...

MPEP § 706.07(a) imposes two separate requirements before prosecution may be closed: (a) all requirements of "present practice" must be timely fulfilled, and (b) no new ground of rejection may be raised, unless necessitated by amendment.

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I. The October Office Action Introduces a New Ground of Rejection of Claim 87, Which is Unamended

Neither the MPEP nor 37 C.F.R. define "new ground of rejection;" that definition must be found in the case law. A "new ground of rejection" is any new line of reasoning that requires a "fair opportunity to react to the thrust of the rejection." *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426 (CCPA 1976). For example, relying on a new portion of a reference is a "new ground of rejection." *In re Wiechert*, 370 F.2d, 927, 933, 152 USPQ 247, 251-52 (CCPA 1967) ("An applicant's attention and response are naturally focused on that portion of the reference which is specifically pointed out by the examiner. ... [W]hen a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-à-vis such portion of the reference").

There is no dispute that the February 2004 Action contains no comparison of the "control-transfer instruction of a computer ... architecturally defined to transfer control directly to a destination instruction" of claim 87 to any reference.

The October 2004 Office Action, at paragraph 14.4, is the first to be "factually based" on col. 15, lines 48-50 of the Brender reference, or anything related thereto.

This is a "new ground of rejection" for two reasons.

The Advisory Action of February 14, 2005 rests on the definition of "new ground" of rejection as no more than naming the same references. This is an incorrect definition of "new ground of rejection." Every case that has construed the term "new ground of rejection" rejects the simplistic approach stated in the Advisory Action. *See, e.g., Wiechert*, 370 F.2d at 933, 152 USPQ at 251-52 (reliance on a "different portion of an existing reference" is a new ground); *Kronig*, 539 F.2d at 1302-03, 190 USPQ at 426; *Ex parte Albrecht*, <http://www.uspto.gov/web/offices/dcom/bpai/decisions/fd000460.pdf> (BPAI 2002) (unpublished) (vacating the examiner, and ordering that the applicant be given "a full and fair opportunity to respond," because the examiner raised a "new ground of rejection" by shifting emphasis within a group of references, without introducing a new reference). MPEP § 706.07(a) itself contrasts "new ground of rejection" and "a rejection, on newly-cited art," showing that they are two separate things – the attendant circumstances that apply to the two cases are somewhat different. Notably, the Advisory Action cites no authority for its definition of "new ground of rejection," or any basis to

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deviate from the instructions of the CCPA and the Board of Patent Appeals, or to redefine established legal terms. The October Office Action was not properly made final.

Second, there was no rejection whatsoever of claim 87 in the February 2004 Office Action. To raise a rejection requires three steps, and the February 2004 Office Action only performed one. 37 C.F.R. § 1.104(c) reads as follows:

§ 1.104 Nature of examination.

- (a)(2) The reasons for any adverse action .. will be stated in an Office action...
- (c)(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Rule 104 states three requirements: (1) there must be a statement of what claims are rejected and for what reason, (2) for any rejection under §§ 102 or 103, the "particular part relied on" for each reference must be designated, and (3) the pertinence of each reference must be "clearly explained."

The February 2004 Office Action meets only the first step with respect to claim 87: as the Examiner concedes in his February 2005 Advisory Action, the only discussion of claim 87 is the summary statement in ¶¶ 46 and 100 of the February 2004 Action that claim 87 is rejected. Rule 104 makes clear that simply stating that a claim is rejected is not the same thing as rejecting the claim. Nowhere in the February 2004 Action (let alone in ¶¶ 46 and 100) is there even the slightest attempt to designate the particular parts relied on to meet claim 87 (particularly the "instruction being architecturally defined to transfer control directly to a destination instruction for execution in a second execution context of the computer."), let alone a clear explanation of "pertinence" of those references.

The Request to Withdraw Finality of January 2005 requests the identification of any substantive discussion of claim 87 in the Office Action of February 2004. The Advisory Action of February 2005 concedes that there is none – it can only point to summary statements in ¶¶ 46 and 100, which are inadequate to meet the requirements for setting out a rejection. With that concession, any claim to final rejection evaporates.

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Examination of claim 87 is untimely. At best, the October 2004 Action raises a new ground of rejection not necessitated by any amendment. Under MPEP § 706.07(a), finality of the Action of October 2004 is premature.

II. The Status of Claim 22 is Too Unclear to Permit Appeal or Closure of Prosecution

As noted in the accompanying Second Response to Office Action, no clear position on claim 22 is stated in any of the Examiner's papers. Because the Office Actions do not meet the requirements of 37 C.F.R. § 1.113(b) ("In making such final rejection, the examiner shall ... clearly [state] the reasons in support thereof."), or MPEP § 706.07 ("any such grounds relied on in the final rejection ... must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal"), prosecution may not be closed.

MPEP § 706.07 also makes clear that any final rejection must be stated in no more than two papers: the "single" previous Office action, and one final paper. The Examiner attempts to cure previous omissions in the February Advisory Action. However, an Advisory Action is both untimely, and improper in its attempt to inject a third paper into any appeal. Thus, the procedural requirements for closing prosecution are not satisfied.

Until grounds are explained timely and "clearly" in no more than two papers, Rule 113 and MPEP § 706.07 make clear that closing of prosecution is premature.

III. "Present Procedures" For Examination of the Application Were Not Completed – Closing of Prosecution Is Premature

A number of non-patent references submitted on the Form 1449 filed July 12, 2004, and returned with the Action of October 2004, are crossed off the Form 1449 without consideration. The pertinent rule reads as follows:

§ 1.98 Content of information disclosure statement

d) A copy of any ... publication ... listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

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- (1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and
- (2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

A. Non-Patent References Were Refused Consideration for an Incorrect Reason

First, the Examiner does not dispute that all non-patent references listed on all IDS's filed in this application comply with Rule 98(d)(1): copies were "submitted, or cited by, the Office in an earlier application," they were submitted in those priority applications in fully-compliant IDS's, those priority applications are "properly identified" in the IDS's of this application, and are relied on for earlier effective filing dates under § 120.

The Examiner nonetheless refuses to consider these references. His reason appears to be a new requirement, not stated in Rule 98: he will only consider references in the IFW of the direct parent, not in a "grandparent." Advisory Action of February 14, 2005 at page 3, line 14. But Rule 98(d)(1) states that a non-patent reference in the file of any priority application may be relied upon, so long as that priority application is identified in the IDS.

B. United States Patent References Were Refused Consideration for No Apparent Reason

Similarly, a number of United States patents are crossed off the Form 1449 without consideration. No reason for refusing consideration of these references is stated.

Applicant notes that no copies of these references were required to be submitted. By Final Rule published under the authority of Director Dudas in the Official Gazette on Oct. 12, 2004, and effective October 21, 2004¹ (before the Office Action at issue here was issued), 37 C.F.R. § 1.98(a)(2)(i) "is amended to eliminate the requirement ... for a copy of each U.S. patent or U.S. patent application publication listed in an IDS in a patent application ..." The OG notice explains that once an application has been converted to IFW form, the need is "[obviated] ... for

¹ In oral presentations to the public (for instance, at AIPLA meetings, etc.) by senior patent Office officials, for about two years before this formal rule change, the Office has encouraged applicants to omit paper copies of U.S. patents, at least for applications that had been converted to IFW. See Official Gazette Notice of 17 September 2002, "Electronic Submission of Information Disclosure Statements." Copies of U.S. patents were omitted pursuant to the representations.

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a copy of the cited U.S. patent documents. ... Accordingly, it will no longer be necessary to require a copy of each cited U.S. patent or U.S. patent application publication in an IDS regardless of the filing date of the application..." In pertinent part, Rule 98 was revised to read as follows:

Sec. 1.98 Content of information disclosure statement.

(a) Any information disclosure statement filed under Sec. 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

(2) A legible copy of:

(ii) Each publication or that portion which caused it to be listed, other than U.S. patents ...

Examiner Ellis disagrees with the Director. He insists that copies of U.S. Patents be submitted, even though the rules no longer require such copies, because they will be simply thrown away without being scanned in to the IFW. Examiner Ellis does not have the authority to refuse consideration of these references.

Because "present practice" was not observed in the Office Action of October 2004, MPEP § 706.07(a) does not authorize closure of prosecution. Because refusal of these references was not authorized, prosecution should be reopened so that the Examiner can complete examination of the entire application.

IV. No Complete Advisory Action Has Been Issued

Two papers were timely filed on January 25, 2005: a Response to Office Action and a Request to Withdraw Finality. The Advisory Action of February 2005 only responds to only one. Because no Advisory Action was addressed to the Response to Office Action, the Examiner's current position on the substantive issues is unclear. Final rejection is premature.

A Second Response to Office Action is enclosed herewith. Applicant requests that the Examiner act on all issues before him.

V. Conclusion

For these reasons, the finality of the Action of October 25, 2005 should be withdrawn. Prosecution should be reopened, and the Amendment filed concurrently herewith should be entered as of right (even without a showing of reasons under Rule 116).

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In the event this Request is granted, Applicant requests the opportunity to fully respond to the October Office Action, without the constraints of Rule 116.

It is believed that this paper occasions no fee. Kindly charge any fee due to Deposit Account No. 23-2405, Order No. 114596-03-4000.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: April 14, 2005

By: 

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